

REMARKS/ARGUMENTS

This is Applicants' response to the Office Action of May 1, 2008 which was made Final. No new amendments are made in this paper from the previous-filed Amendment on February 12, 2008.

The Final Office Action of May 1, 2008 includes the statement "since the intent to broaden was not presented within 2 years of the patent date, a broadening reissue cannot be granted by the Examiner." However, the statement and the conclusion cannot be supported by the mere fact that "Applicant does not make a statement that the reissue is a broadening reissue until the second Preliminary Amendment filed on 10/20/04, which is more than 2 years after the patent has issued." The Examiner has made no finding of fact that intent to file a broadening reissue application was not conveyed or cannot be inferred from the reissue application declaration by the inventor which included the statement that "I verily believe that the original patent to be wholly or partly inoperative or invalid, for the reasons described below (check all boxes that apply.) ... by reason of patentee claiming more or less than he had a right to claim in the patent." The statement "by reason of a patentee claiming more or less than he had a right to claim in the patent" is clearly a statement of intent to file a broadening reissue application. Clearly, where a patentee states that the patentee claimed less than he had a right to claim in the patent that patentee is intending to claim more and broaden the claims in a reissue application. Since there has been no finding of fact regarding this issue, the rejection of broadening claims in the reissue application is improper.

With respect to Applicants' position with the Amendment filed on November 21, 2003, Applicants intended to broaden independent claim 1 because the addition of the word "no" changed the resistivity range of the mixture. The Examiner has stated that the limitation "a resistivity no greater than about 50 ohm-cm" is present in patent claim 8. Furthermore, the Examiner states that claim 1, as amended on 11/28/03 is not broader than patent claim 8. However, such is not a basis for denial of a broadening reissue application. The Examiner has cited no authority for the position that a broadening reissue application must include a claim that is broader than every claim in the issued patent. Denial of the broadening reissue application and the rejection of claims 9-172 is therefore improper.

The Examiner has also taken the position that MPEP 1412.03 sets forth that a broadening reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. However, MPEP 1412.03 also states:

A claim in a reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly-added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then the reissued claims would be broader than the patent claims.

A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original claims only the process, the reissue application adds (for the first time) product claims, the scope of the claims have been

broadened since a party could not be sued for infringement of a patent based upon the claims of the original patent.

Although the Examiner's dissertation on whether claim 1 is broader in some respects and narrower in other respects than claim 8 and vice versa is interesting, such has little to do with determining whether Applicants' broadening reissue application can be properly denied. The Examiner has provided no evidence or argument to refute Applicants' position that amended claim 1 in the reissue application includes subject matter not covered by the patent claims and therefore enlarges the scope of the patent claims. Denial of Applicants' broadening reissue application is improper.

Furthermore, the Examiner has presented no evidence and made no finding that amended claim 1 would not read on something which the original claims do not and therefore is not a broadening claim. Furthermore, the Examiner has presented no evidence and made no finding that amended claim 1 would not allow a patent owner to be able to sue a party for infringement who previously could not have been sued for infringement. Applicant repeats its position earlier stated which has not been denied by the Examiner, that if a party produced a fuel cell including the structure shown in FIG. 4 of the instant application using a plurality of electrically conductive particles dispersed throughout an oxidation-resistant and acid-resistant, water-insoluble polymer mix having a resistivity no greater than 50 ohm-cm, neither patent claim 1 nor patent claim 8 of issued Patent 6,372,376 would read on such a device. However, amended claim 1 would indeed read on the embodiment shown in FIG. 4 of the instant application, and therefore claim 1 is a broadening reissue claim and Applicant is entitled to submit subsequent

broadening reissue claims as set forth in claims 9-72 after 2 years from the date the patent was granted. The Examiner has not denied such and has presented no evidence or any finding regarding Applicant's position which is completely consistent with MPEP 1412.03 as a basis for allowing a broadening reissue application.

Again, Applicants note that the Examiner has not made a finding of fact that the inclusion of the word "no" immediately prior to "greater than 50 ohm-cm" in the amendment of claim 1 did not broaden claim 1 to cover subject matter not covered by the limitation "having a resistivity greater than about 50 ohm-cm". Although claim 1 might be narrower in some respects, any amendment which broadens any aspect of claim 1 results to broaden claim 1.

In view of the above remarks, Applicants respectfully request reconsideration and notice of allowance of all the claims now in the case.

Respectfully submitted,

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